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Atty. Docket No. STE01 P-798B

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Rebecca A. Westers  
Rebecca A. Westers

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.	:	08/998,302
Appellant	:	Joel D. Stanfield et al.
Art Unit	:	2635
Confirmation No.	:	2417
Filing Date	:	December 24, 1997
For	:	ELECTRONIC SYSTEM, COMPONENTS AND METHOD FOR TRACKING FILES

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Assistant Commissioner for Patents  
Washington D.C. 20231

REPLY BRIEF

In response to the Examiner's Answer mailed on November 13, 2002, Appellants submit this Reply Brief to address the Examiner's response to Appellants' arguments. The Examiner's Answer appears to repeat the rejections set forth in the last Office Action and only addresses the specific arguments made by Appellants beginning on page 8 of the Examiner's Answer. Below, Appellants address each of the paragraphs set forth beginning on page 9 and ending on page 15.

Appellants wish to thank the Examiner for the concession as to the rejections of claims 53-63, which have been withdrawn. Claims 53-63 are now allowed.

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It is noted that the Examiner did not address Appellants' arguments with respect to claims 35 and 37. Appellants submit that claims 35 and 37 are allowable for the reasons stated in the Appeal Brief.

In the first paragraph on page 9 of the Examiner's Answer, the Examiner points out that Smith et al. discloses in column 3, lines 10-15 their desire of having fewer dedicated wires and reducing expense. The Examiner then states that this is the exact motivation offered by the Examiner to combine the teachings of Kott and Smith et al., since Kott provides communication to each folder without requiring dedicated wires or cable to each folder. Thus, it is apparent the Examiner is relying upon a suggestion in the primary reference, Smith et al., to provide motivation for something that Smith et al. does not itself teach, namely, even further reduction of wiring and expense than what is disclosed in Smith et al. As Appellants have set forth in great detail in the Appeal Brief and further below, it is Appellants' position that the modification proposed by the Examiner would destroy the functionality of the Smith et al. system and would significantly change the principle of operation.

In the second paragraph on page 9 of the Examiner's Answer, the Examiner suggests that the Appellants argued that Smith et al. could not operate with file folders. This statement is not entirely correct insofar as it is Appellants' position that one skilled in the art would not have found the Smith et al. system to be a practical system to use to track file folders. In other words, one skilled in the art would not have found it desirable to modify the Smith et al. system to track file folders. In the last sentence of this paragraph, the Examiner states that Smith et al. is directly concerned with organizing and locating articles, which is exactly the same concern (or problem solved) as Kott and the presently claimed invention. Appellants

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recognize, however, that any two systems, albeit unrelated, can be generalized to the point that they have something in common. Nevertheless, the issue is what one skilled in the art would have reasonably expected to construct based upon the cited references without knowledge of Appellants' invention.

In the first full paragraph on page 10 of the Examiner's Answer, the Examiner points out that Kott discloses sending a unique address to a particular article when a common communication bus is used. Appellants do not dispute that Kott discloses sending a unique address of the docket card holder down a common communication bus. However, it is Appellants' position that one skilled in the art would not have considered modifying the Smith et al. system to employ such a common communication bus. In the last sentence of this paragraph, the Examiner states "Note that Smith uses a common bus to communicate to the different power data modules and communicates to these using polling messages that are commonly uniquely addressed messages, see abstract and figure 1." [Emphasis added] Smith et al., however, does not send uniquely addressed messages *to the articles* to be located, however, which is the focus of the claims to which these arguments apply.

In the second full paragraph on page 10, the Examiner again mischaracterizes one of Appellants' arguments when he states "The appellants argue that Smith does not transmit a reply signal back to the controller including the unique serial number of the article." Appellants agree that Smith et al. does send a reply signal from the control circuits 42 to the host computer. However, Appellants were arguing that Smith et al. does not disclose that the articles to be located themselves send a reply signal in response to a signal that is sent to the articles that includes the unique identification of that article. These points are significant in

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view of the recited claim language. The Examiner appears to be ignoring the specific language of the claims in his analysis.

In the paragraph beginning on page 10 and ending on page 11, and in the first full paragraph on page 11, the Examiner correctly points out that Kott does not disclose that the indicator or the docket card transmits any signals back to the processor. While Appellants recognize that the Examiner was relying on Smith et al. for this feature, Appellants are merely pointing out that, given the nature of the Kott system, which employs a common bus connecting to each of the articles to be located, one cannot determine where within the docket card holder the docket card is located even if the docket cards could transmit a signal back in reply to the processor. This is contrary to the teachings of Smith et al., which operates on the principle that there is one article per slot in the carrier. If the dedicated lines extending from control circuit 42 to each of the tape carrier slots were replaced with a common communication bus, the control circuit 42 would then be incapable of determining from which slot a particular article responded. This would destroy the ability of the Smith et al. system to determine the exact location of the article. In the last full paragraph on page 11, the Examiner addresses this argument by stating that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, but rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. It is apparent that the Examiner has quoted a portion of MPEP §2145.III. However, the Examiner has conveniently left out the portion of this section of the MPEP which states:

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However, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See MPEP §2143.01.

Thus, the portion the Examiner has cited is essentially irrelevant insofar as the Examiner has recognized that Appellants have argued that using the teachings in Smith et al.'s system would destroy the ability of Smith et al. to determine the specific location of an article.

The Examiner further states in the last sentence of the last paragraph on page 11 that the teachings of Kott would aid in Smith et al.'s objectives by reducing the number of wires between the power data modules and the articles, and would in no way destroy the ability of Smith et al. to determine the location of an article. The Examiner, however, has not stated how the Smith et al. system would operate if the memory read enable signals were transmitted to all of the slots simultaneously over a common bus instead of over dedicated wires. This is likely because the control circuit 42 would then be incapable of determining from which slot a tape cartridge responded. Thus, the control circuit 42 would be wholly incapable of determining from which slot a particular tape was located. Clearly, this is contrary to the principles of operation of the Smith et al. system and would destroy the ability of the system to identify the specific location of the tape or other article. It is noted that the Examiner does not otherwise address this argument or support his position with any evidence or detailed logic.

In the first paragraph on page 12, the Examiner states that Appellants' argument that the references cannot be physically combined is contrary to the intent of an obviousness rejection. Again, however, we are not arguing that the structures cannot be physically combined, but rather that such a combination would significantly change the principles of

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operation of the Smith et al. system and destroy its ability to identify the specific locations of the articles within the tape carriers.

In the second full paragraph on page 12, the Examiner notes that Appellants argue that Smith et al. fails to show accessing a memory device to determine the location of the article. What Appellants had actually argued, however, is in the first full paragraph on page 45 of the Appeal Brief, in which Appellants stated "None of the references whether considered separately or in combination teaches a system whereby two unique addresses are accessed from a database and then transmitted in a single file request."

In the paragraph beginning on page 12 and ending on page 13, the Examiner contends that Appellants only made a broad sweeping statement that Wakura does not provide the specific structure of claim 28 without providing any particular reasoning as to what is missing from the references forming a combination rejection. Appellants noted, however, on page 46 of the Appeal Brief, the last half of the last paragraph, that one of ordinary skill in the art would not have been motivated to modify the Smith et al. system based on the teachings of either Kott or Wakura such that the system in Smith et al. would transmit the unique address of a file cabinet in any request signal it transmits. Appellants specifically noted that each of the tape carriers in the Smith et al. system is connected to the host processor 52 over a common communication channel, and yet, host computer 52 does not transmit a unique address associated with any one tape carrier. Instead, the host computer 52 sends out the unique identifier for the tape for which it is searching, which is broadcast globally to all of the control circuits 42 associated with the tape carriers. Each control circuit 42 then polls the tapes contained in the associated carrier and reports back to the host processor if it finds a match.

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Upon reporting back, the control circuit 42 provides an identification of itself or the tape carrier with which it is associated. At no point, however, does *the host computer* transmit the identification of the control circuit 42 or a tape carrier.

In the first full paragraph on page 13, the Examiner states that the Appellants argue that they are not clear why an artisan would modify Smith et al. to include a display since Smith et al. is designed for use with a robotic arm. However, Appellants never made any such argument. In fact, the only mention of a display in the Appeal Brief appears on page 37, lines 10-13 in which Appellants admitted that the host computer 52 displays the identification of the tape carrier whose microcontroller responded to a tape request.

In the last full paragraph on page 13, the Examiner states that he believes it is inherent in Smith et al. that a signal is sent directly to the article that uniquely identifies the article and the cabinet where the article is located. The Examiner then references column 10 of Smith et al. and contends that this portion of Smith et al. discloses that the power modules 64 poll the articles 12 to find the location of the article and upon determining the location of the requested article, a message is sent to the display. Appellants do not disagree with this interpretation of Smith et al. However, the Examiner goes on to state "Note that the signals of Smith may be on different lines, but those lines do provide signaling directly to the article that uniquely identifies the article and the location of the article." There is no signal in Smith et al. that is sent from the host processor 52 or from the microprocessors 300 to the article 12 that includes the article's unique identification. Instead, the unique identification of the tape carrier is only transmitted from the host processor 52 to the various microprocessors 300 and not directly to the articles themselves. Further, the location of the article is transmitted only from the

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microprocessor 300 to the host processor 52. As noted above, nowhere does Smith et al. disclose that any identification code of the tape carrier or control circuit 42 is transmitted in a signal originating from host processor 52.

In the first paragraph on page 14, the Examiner states that the Appellants' arguments relating to claims 30-33 appear to be the same as the arguments presented on pages 41 and 42 of the Appeal Brief. The Examiner therefore did not further address the arguments pertaining to claims 30-33. However, Appellants submit that the arguments were not the same. Specifically, on pages 41 and 42, Appellants were addressing whether there would have been motivation to include the unique identification code of a file folder in a signal sent from a processor to the file folders themselves. With respect to claims 30-33, however, Appellants addressed the features recited in independent claim 30, which pertain to a common communication bus to which at least two of the file folders are coupled. Appellants' arguments further pointed out that modifying the Smith et al. system such that a common communication bus was utilized to communicate with two tapes or articles would destroy the ability of the Smith et al. system to determine in which of the slots a particular tape or article is located.

In the second and third paragraphs on page 14, the Examiner is referencing a specific feature in Kott whereby a docket card folder may make contact with the conductive rail bus regardless of whether the docket card folder is placed in the front of the box or the rear of the box. The Examiner further states that Kott includes a plurality of contacts on the docket card folder, which are inherently at different locations on the folder. Regardless of these arguments, it would not have been obvious to utilize the conductive rail disclosed in Kott or this particular configuration for that matter in the system of Smith et al. since providing a



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plurality of docket card folders or file folders along a common communication bus would destroy the ability of Smith et al. to determine the precise location of each article to be located.

In the last sentence on page 14, the Examiner states "The appellant is attempting to read limitations into the claim that do not exist by stating that figures 5 and 6 define the claims." Nowhere, however, did Appellants make this statement. Appellants merely stated at the end of the first full paragraph on page 51 of the Appeal Brief, the subject matter of claim 38 corresponds to the various examples shown in Figs. 5 and 6. Appellants recognize that embodiments of a particular invention do not define the invention, but rather the specific language in the claims is what defines the invention.

In the first paragraph on page 15 of the Examiner's Answer, the Examiner states that Smith et al. (and Wakura) teaches the use of databases for storing the location of an article and a manner in which the article is identified (a unique number). The Examiner further states that this identification is considered a "classification" of the article. However, claim 43 recites that the database maintains not only the file location code and unique file addresses for a plurality of files, but additionally general file information including at least one of a description of contents within the file, file classification, a key word list associated with the file, a title of the file, an originator of the file, accessibility permission lists for the file, location description associated with the file location code, and historical information for a plurality of files. If the Examiner considers the unique number associated with the article to correspond to the recited "file classification," then the database does not otherwise store any separate unique file address or file location code.

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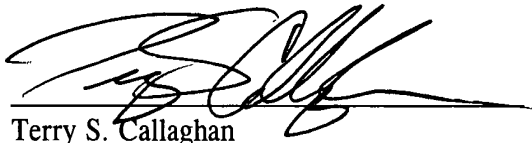
For the reasons set forth above and provided in more detail in Appellants' Appeal Brief filed August 13, 2002, the pending claims define patentable subject matter. Accordingly, reversal of the rejection of the rejected claims is appropriate and respectfully solicited.

Respectfully submitted,

JOEL D. STANFIELD ET AL.

By: Price, Heneveld, Cooper,  
DeWitt & Litton

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Date

  
Terry S. Callaghan  
Registration No. 34 559  
695 Kenmoor, S.E.  
Post Office Box 2567  
Grand Rapids, Michigan 49501  
(616) 949-9610

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